

Response Under 37 CFR § 1.116
Expedited Procedure – Group Art Unit 2855

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Chuxin CHEN et al.	§	Confirmation No. 2855
Serial No.: 10/689,370	§	Group Art Unit: 2863
Filed: October 20, 2003	§	Examiner: Sun, Xiugin
For: Rule Based Capacity Management System for an Inter-Office Facility	§	
	§	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

The present paper is being filed under the Official Gazette Notice of July 12, 2005, and in response to the Office action mailed December 13, 2006.

A Notice of Appeal with the proper fee is being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for an extension of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

REASONS

In the Office action mailed December 13, 2006, claims 1-20 were pending and under consideration. Claims 1-20 were rejected. Independent claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,999,179 (hereinafter "Kekic") in view of U.S. Patent No. 5,892,317 to Sampath et al. (hereinafter "Sampath"). Independent claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of U.S. Patent No. 6,225,999 to Jain (hereinafter "Jain") and U.S. Patent No. 5,761,432 to Bergholm (hereinafter "Bergholm"). Independent claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of Sampath and U.S. Patent No. 5,678,042 to Pisello et al. ("Pisello"). It is respectfully submitted that there are clear errors with the Examiner's rejection of the claims. More specifically, and as described below, the grounds for rejection are clearly legally deficient because the asserted prior art lacks essential elements needed to establish a *prima facie* rejection with respect to each claim.

MPEP §2142 specifies that:

*The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.*

As further explained in MPEP §2142:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person.

Accordingly, it is incumbent upon the Examiner in the first instance to factually support a conclusion of obviousness of the claims as a whole.

A. Claim 1

A first clear legal deficiency is that claim 1 recites features that are not rendered obvious by the combination of Kekic and Sampath. In particular, the feature:

a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein the one or more analytical reports include a prediction of exhaustion of the equipment, wherein the program includes:

an inference engine having instructions for . . . firing the rule on the data to produce an analysis and to create the one or more analytical reports

is neither taught nor suggested by the combination of Kekic and Sampath. In the December 13th Office action, the Examiner recognized that Kekic fails to teach the above-noted feature, for which he cited Sampath. Applicants respectfully traverse the Examiner's position and submit that column 6, lines 29-46, and column 9, lines 4-30, of Sampath, which were cited by the Examiner as teaching "a program for creating one or more analytical reports" about a monitor set based on the rules and data related to the monitor set . . ." clearly fail to do so. The cited passages merely recite a laundry list of data that can flow between one or more of the electronic systems of Sampath, none of which constitutes an "analytical report" as that phrase is used in claim 1. In view of the fact that Sampath fails to remedy the deficiencies of Kekic, as described above, it is apparent that, even when combined, the references do not teach the subject matter as claimed in independent claim 1; therefore, the subject rejection thereof should be withdrawn.

For the foregoing reasons, the Examiner has failed to carry the burden of establishing a *prima facie* case of obviousness with respect to claim 1, as well as claims 2, 3, and 13-15, each of which depends directly or indirectly from claim 1.

B. Claim 4

A second clear legal deficiency is that the combination of Kekic, Jain, and Bergholm is improper. Section 2142 of the MPEP provides:

the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was

unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

In the present case, neither Kekic, which is directed to a platform independent computer network management client, nor Jain, which is directed to a customizable user interface for network navigation and management, nor Bergholm, which is directed to an apparatus for providing efficient use of telecommunications network resources, teaches, or even suggests, the desirability of the combination of the teachings therein as specified above and as recited in claim 4. Thus, it is clear that none of the cited references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention as recited in claim 4 without any showing, suggestion, incentive or motivation in any of the references for the combination as applied to claim 4. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

In view of the foregoing, the Examiner has clearly failed to carry the burden of establishing a *prima facie* case of obviousness with respect to claim 4, as well as claims 5-9, each of which depends directly or indirectly from claim 4.

C. Claim 10

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

A third clear legal deficiency is that claim 10 recites features that are not rendered obvious by the combination of Kekic, Sampath, and Pisello. In particular, the feature:

a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein at least one of the analytical reports details a relationship between demand and capacity for at least a portion of the equipment

is neither taught nor suggested by the cited combination of references. In particular, as described above with reference to claim 1, the Examiner's characterization of the teachings of Sampath, which is repeated verbatim in the rejection of claim 10, is in error.

Response Under 37 CFR § 1.116
Expedited Procedure – Group Art Unit 2855

2. The Combination of References is Improper

A fourth clear legal deficiency is that the combination of Kekic, Sampath, and Pisello is improper.

In particular, neither Kekic, which is directed to a platform independent computer network management client, nor Sampath, which is directed to a system for failure prediction, diagnosis and remediation using data acquisition and feedback for a distributed electronic system, nor Pisello, which is directed to a network management system having historical virtual catalog snapshots for overview of historic changes to files distributively stored across a network domain, teaches, or even suggests, the desirability of the combination of the teachings therein as specified above and as recited in claim 10. Thus, it is clear that none of the cited references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

As previously noted, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention as recited in claim 10 without any showing, suggestion, incentive or motivation in any of the references for the combination as applied to claim 10. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

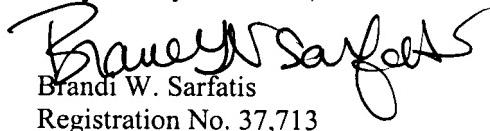
In view of the foregoing, the Examiner has failed to carry the burden of establishing a *prima facie* case of obviousness with respect to claim 10, as well as claims 11, 12, and 16-20, each of which depends directly or indirectly from claim 10.

Response Under 37 CFR § 1.116
Expedited Procedure – Group Art Unit 2855

CONCLUSION

Applicants have therefore demonstrated four clear legal deficiencies in the Examiner's position. Consequently, the rejections are clearly not proper and are without basis and it is therefore respectfully requested that the rejections be withdrawn.

Respectfully submitted,


Brandi W. Sarfatis

Registration No. 37,713

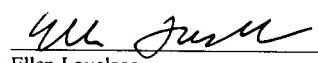
Dated: April 12, 2007

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 214/651-5896
Facsimile: 214/200-0948

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office, via EFS-Web, on the date indicated below:

on April 12, 2007
Date


Ellen Lovelace